

## REMARKS

This Response is submitted in reply to the Office Action dated June 26, 2007. Applicants have amended claims 1, 2, 5, 13, 14, 17, 25, 26, 29, 37, 38, 43, and 50. Applicants have also amended the specification. No new matter has been added by these amendments. Applicants have submitted a Terminal Disclaimer and supplemental declaration along with this Response. A Petition for a Three-Month Extension of Time to Respond to the Office Action is submitted herewith. Please charge to deposit account No. 02-1818 to cover the Terminal Disclaimer fee, Three-Month Extension and any other fees due in connection with this Response.

### **Oath/Declaration**

The Office Action objected to the supplemental Declaration filed on February 23, 2004 as defective for incorrectly stating the filing date of the present application is September 2, 2003 when the filing date of the present application is September 12, 2003. The Office Action states that a new Declaration identifying the present application by application number and filing date is required.

Applicants respectfully question whether a supplemental declaration is necessary, as suggested by the Office Action. The granted Petition mailed from the Office of Petitions on August 23, 2004 shows the filing date of this application to be September 12, 2003. Applicants filed the original declaration on September 12, 2003, along with the subject application. The original declaration listed both inventors, Wing Yee Ngan and Randall D. Mead, of the subject application, but was not executed.

Applicants filed a supplemental declaration on February 23, 2004. The supplemental declaration correctly identified the subject application by serial number (i.e., 10/661,036) and title (i.e., "GAMING DEVICE HAVING MULTIPLE SELECTION GROUPS WITH RANDOMLY ALIGNING ADVANCES"), but inadvertently listed the filing date of the subject application as September 2, 2003.

Applicants recorded the assignment for the present application on February 23, 2004 on reel 014993, frame 0075. This assignment is executed by both inventors on

October 15, 2003 and correctly identifies the subject application by serial number, title and a filing date of September 12, 2003.

Applicants submit that the September 2, 2003 filing date listed on the supplemental declaration was a typographical error (i.e., the 1 was not placed before the 2 in the number 12). Clearly the subject application (i.e., the present application) of the supplemental declaration filed on February 23, 2004 was correctly identified by serial number and title. For at least this reason, Applicants believe that a supplemental declaration, as suggested by the Office Action, is not necessary.

Nonetheless, Applicants have submitted a supplemental declaration listing the correct filing date in conjunction with this Response. The supplemental declaration has been executed by one of the inventors, Wing Yee Ngan. Applicants have been unable to reach the other inventor, Randall D. Mead, after a reasonable and diligent effort. The Assignee, IGT, sent a copy of the Supplemental Declaration to Randall Mead at his last known address (i.e., 1850 Joy Lake Road, Reno, Nevada 89511) on December 12, 2007 via certified mail. Applicants have submitted the certified mail receipt as evidence of this mailing. Additionally, the Assignee and Applicants have placed numerous telephone calls to Randall D. Mead at his last known telephone number. Neither Applicants, nor the Assignee, have received a response from Randall D. Mead as of December 21, 2007. If either the Assignee or Applicants receive a response from Randall D. Mead, Applicants will notify the U.S. Patent and Trademark Office accordingly and provide a supplemental declaration executed by Randall D. Mead, if possible. If any Petition is needed for the present application, Applicants respectfully request that the Examiner contact the undersigned.

### **Objections**

Applicants have amended the specification and claims to correct grammatical errors noted in the Office Action.

### **Double Patenting**

The Office Action provisionally rejected Claims 41, 43, 48, 49, 54, and 55 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18, 21, 23, 24, 32, and 33 of co-pending Application No. 10/243,047. Accordingly, in conjunction with this Response, Applicants have submitted a Terminal Disclaimer for co-pending application 10/243,047, which issued as U.S. Patent No. 7,273,415 on September 25, 2007.

### **Claim Rejections - §112, second paragraph**

The Office Action rejected Claims 2 and 25 under 35 U.S.C. §112, second paragraph. Applicants respectfully disagree with and traverse this rejection for the following reasons.

Amended claim 2 recites "wherein if the player picks one of the selections associated with one of the advances, said pick caused by said advance does not count against the number of picks." Applicants respectfully submit that amended claim 2 complies with Section 112, second paragraph.

Claim 25 recites "an award adapted to be provided to the player if for each of two picks by the player: (a) the player picks one of the selections with an associated advance, (b) the advance causes the pick of one of the selections associated with a subsequent one of the selection groups, and (c) another one of the advances is associated with the selection caused to be picked by the advance." In claim 25, (a)..., (b)..., and (c)... represent conditions which, when satisfied for each of two picks by the player, causes the award to be provided to the player. For example, for the award to be provided to the player, conditions (a)..., (b)..., and (c)... must be satisfied for a first pick and a second pick by the player. Applicants respectfully submit that claim 25 complies with Section 112, second paragraph.

### **Claim Rejections - §102(b)**

The Office Action rejected claims 41, 43, 48, 49, 54, and 55 under 35 U.S.C. §102(a) as being anticipated by Hughs-Baird (U.S. Patent No. 6,439,995).

The Office Action rejected claims 54 and 55 as being anticipated by Hughs-Baird. However, claims 54 and 55 are dependent claims which depend from independent claim 50. The Office Action did not reject independent claim 50 as being anticipated by Hughs-Baird. Accordingly, dependent claims 54 and 55 are not anticipated by Hughs-Baird.

The Office Action stated that "Hughs-Baird discloses...(c) providing an advance award to the player for advancing through each of the groups if a number of picks used to advance through the groups is less than or equal to a provided number of picks (col. 13, lines 1-43). Applicants respectfully disagree that this section of Hughs-Baird anticipates independent claim 41. Specifically, col. 13, lines 1-43 of Hughs-Baird describes a try again feature which enables a player to repeat one or more rounds previously played. The try again feature of Hughs-Baird does not constitute an advance award which is provided to the player for advancing through each of the groups if a number of picks used to advance through the groups is less than or equal to a provided number of picks. Moreover, the try again feature of Hughs-Baird does not determine the number of picks used by a player to advance through the groups, and does not provide an advance award in relation to the number of such picks. For at least these reasons, Hughs-Baird does not anticipate independent claim 41 and its dependent claims 43, 48, and 49. Accordingly, independent claims 41, 43, 48, and 49 are patentable over Hughs-Baird and in condition for allowance.

#### **Claim Rejections - §103(a)**

The Office Action rejected claims 1-40, 44-47, and 50-53 under 35 U.S.C. §103(a) as being unpatentable over Hughs-Baird in view of Kamille (U.S. Patent No. 5,855,514). Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

Independent claim 1 is directed to a gaming device which comprises a plurality of selection groups, a plurality of selections in each of said selection groups, and a plurality of advances adapted to be associated with the selections. At least one selection of each of the different selection groups has one of the advances associated

with the selection. A number of picks from the selection groups is adapted to be provided to a player. An advance award is adapted to be provided to the player if: (a) the player picks one of the selections with an associated advance, (b) said advance automatically causes the pick of one of the selections associated with a subsequent one of the selection groups, and (c) another one of the advances is associated with said selection caused to be picked by the advance. A display device is adapted to display the selection groups, advances and advance award.

The Office Action stated that "Hughs-Baird fails to disclose (b) said advance causes the pick of one of the selections associated with a subsequent one of the selection groups, and (c) another one of the advances is associated with said selection caused to be picked by the advance." The Office Action relied on Figs. 6B and 7C of Kamille to disclose such features.

Kamille discloses a probability game which allows for interactive play. Figs. 6B and 7C of Kamille disclose directionals which direct a player to play the game pieces in a specific way. Such directionals direct a player's choice as to which play areas to uncover on a playing surface (col. 9, lines 55-57). In Kamille, each game piece is played one play area (e.g., spot on the playing surface) at a time. However, any play area could void the game piece. Thus, the responsibility for careful play rests on the player. That is, the player decides when to stop or when to go on. The player continues to play by uncovering a winning amount, encountering a null, directional or blank area or by voiding the game piece (col. 5, line 63 to col. 6, line 2). Accordingly, a player playing Kamille's probability game incurs risk with each selection because each selection can void the game piece. Contrary to the advances of independent claim 1, the directionals do not automatically cause the pick of another play area on the game piece. Rather, the directionals direct the player as to which play area to pick if the player chooses to continue to play the game piece. For these reasons, the proposed combination of Hughs-Baird and Kamille does not render obvious independent claim 1. Applicants respectfully submit that independent claim 1 and its dependent claims 2-12 are patentable over the proposed combination and in condition for allowance.

Independent claims 13 and 25 are each directed to a gaming device which comprises, among other elements, an award adapted to be provided to the player if: (a) the player picks one of the selections with an associated advance, (b) the advance automatically causes the pick of one of the selections associated with a subsequent one of the selection groups, and (c) another one of the advances is associated with the picked selection caused to be picked by the advance, and at least one pick is remaining.

For similar reasons as given above with respect to independent claim 1, Applicants respectfully submit that independent claims 13 and 25 and respective dependent claims 14-24 and 26-36 are patentable over the proposed combination and in condition for allowance.

Independent claim 37 is directed to a gaming device which comprises, among other elements, an advance award adapted to be provided to the player if: (a) the player picks one of the selections with an associated advance, (b) the advance automatically causes the pick of one of the selections associated with a subsequent one of the selection groups, (c) a second one of the advances is associated with said selection caused to be picked by the advance, and (d) the second advance automatically causes the pick of one of the selections associated with a subsequent one of the selection groups or the advance award.

For similar reasons as given above with respect to independent claim 1, Applicants respectfully submit that independent claim 37 is patentable over the proposed combination and in condition for allowance.

Independent claim 38 is directed to a gaming device which comprises, among other elements, an advance award adapted to be provided to a player if the first selection picked generates the first advance and the first advance automatically causes the second selection associated with the picked first selection to be picked wherein the second selection generates a second advance.

For similar reasons as given above with respect to independent claim 1, Applicants respectfully submit that independent claim 38 and its dependent claims 39 and 40 are patentable over the proposed combination and in condition for allowance.

Independent claim 50 is directed to a method of operating a gaming device, wherein the method comprises: (a) enabling a player to pick from a first selection group until the player picks a first advancement; (b) if the first advancement does not generate a second advancement in a second selection group, enabling the player to pick from the second selection group until the player picks the second advancement; and (c) providing an advance award to the player for advancing through the groups within a designated number of player picks, wherein a second advancement is obtained without counting against the number of picks if it is generated directly after the first advancement is generated.

The Office Action stated that "Hughs-Baird fails to disclose wherein a second advancement is obtained without counting against the number of picks if it is generated directly after the first advancement is generated." The Office Action relied on Figs. 6B and 7C of Kamille to disclose such features.

As mentioned above, Kamille discloses a probability game in which a player plays each game piece one play area (e.g., spot on the playing surface) at a time to discover prize amounts. The player decides when to stop or when to continue after each selection. The player incurs risk with each selection because each selection can void the game piece. In one embodiment, Kamille limits the number of attempts for the player. For example, if a player does not find a prize in a limited number of attempts or if a void area is encountered, the game ends (col. 5, lines 50-52). Thus, Kamille discloses limiting the number of attempts for the player but Kamille does not provide an award to player based on the limited number of attempts. For at least these reasons, Kamille does not disclose providing an advance award to the player for advancing through the groups within a designated number of player picks, wherein a second advancement is obtained without counting against the number of picks if it is generated directly after the first advancement is generated, as in independent claim 50. Accordingly, the proposed combination of Hughs-Baird and Kamille do not render obvious independent claim 50 and its dependent claims 51-53. Applicants respectfully submit that independent claim 50 and its dependent claims 51-53 are patentable over the proposed combination of Hughs-Baird and Kamille and in condition for allowance.

The Office Action rejected claim 42 under 35 U.S.C. §103(a) as being unpatentable over Hughs-Baird in view of Jaffe (U.S. Patent No. 6,443,837). Applicants respectfully disagree with and traverse this rejection for the following reasons.

As mentioned above, Applicants respectfully disagree that Hughs-Baird anticipates independent claim 41. Specifically, col. 13, lines 1-43 of Hughs-Baird relate to a try again feature which enables a player to repeat one or more rounds previously played. The try again feature of Hughs-Baird does not constitute an advance award which is provided to the player for advancing through each of the groups if a number of picks used to advance through the groups is less than or equal to a provided number of picks. Moreover, the try again feature of Hughs-Baird does not determine the number of picks used by a player to advance through the groups, and does not provide an advance award in relation to the number of such picks.

The Office Action relied on Jaffe to disclose or teach providing a separate number of picks for first and second selection groups. However, Jaffe does not disclose or teach providing an advance award to the player for advancing through each of the groups if a number of picks used to advance through the groups is less than or equal to a provided number of picks, as in independent claim 41 and dependent claim 42. For at least this reason, the proposed combination of Hughs-Baird and Jaffe does not render obvious dependent claim 42. Accordingly, dependent claim 42 is patentable over the proposed combination of Hughs-Baird and Jaffe and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.



Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY



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